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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,498	12/17/2001	William Milam JR.	MILAM-003	4286

7590

06/15/2005

INTELLECTUAL PROPERTY DEVELOPMENT
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EXAMINER

YODER III, CHRISS S

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,498

Applicant(s)

MILAM ET AL.

Examiner

Chriss S. Yoder, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

Applicant argues that application No. 10/023,494 did not include limitation for a quick-release coupling and other features included in the present case and that these additional limitations are sufficiently distinct such that an obvious-type double patenting rejection does not apply to the instant matter. The Examiner agrees that application No. 10/023,494 did not include limitation for a quick-release coupling and other features included in the present case. However, the claims of application No. 10/023,494 are more broad in scope than the claims of this application, therefore, any patent granted on it would result in the unjustifiable timewise extension of the monopoly eventually granted on the claims of application 10/023498. Additionally, it is important that these two inventions are always commonly owned. As an example, if a patent was to be granted for both applications (one broad and one specific), if someone were to infringe on the specific patent, they would inherently be infringing on the broad patent, and therefore the nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 7, 8, and 13-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 9-11 of copending Application No. 10/023494. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons discussed below.

Claims 1 and 7 are more broad in scope than claim 1 of application 10/023498, therefore, and patent granted on it would result in the unjustifiable timewise extension of the monopoly eventually granted on claim 1 of application 10/023498. Additionally, it is important that these two inventions are always commonly owned.

Claim 2 is verbatim the same as claim 2 of 10/023494.

Claim 8 is verbatim the same as claim 2 of 10/023494.

Claim 13 is more broad in scope than claim 9 of application 10/023498, therefore, and patent granted on it would result in the unjustifiable timewise extension of the monopoly eventually granted on claim 9 of application 10/023498. Additionally, it is important that these two inventions are always commonly owned.

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Claim 14 is verbatim the same as claim 10 of 10/023494.

Claim 15 is verbatim the same as claim 11 of 10/023494.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 03/15/2005 have been fully considered but they are not persuasive.

Applicant argues that Lee (US Patent # 6,147,797) does not disclose the use of a lens mount, but instead discloses a "skirt", 214. The examiner would like to point out that although Lee calls this a "skirt" this is considered to be a "lens mount" by the examiner as it performs the exact same functions as a "lens mount" regardless of what it is called in the reference. Applicant also states that this cannot be considered a lens mount because of the fact that there is an operative lens 212 provided in the camera. However, as further evidence that this is the equivalent of a lens mount, the examiner provides an additional reference that discloses the use of a lens mount on a camera having an internal lens. Niikawa et al. (US Patent # 6,704,053) discloses the use of a camera 1 having a lens mount 20 and an internal lens 302.

Applicant argues that Lee (US Patent # 6,147,797) does not disclose the use of a lens emulating flange opposing a coupling because the camera has a lens 212 fixed in the camera, therefore, it does not serve to emulate a camera lens. However, just because there is a lens 212 fixed in the camera 210, does not prevent the adapter disclosed by Lee from emulating a lens. As further evidence of this, the examiner refers

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to Niikawa et al. (US Patent # 6,704,053) in figure 2, reference numerals 301 and 302.

As can be seen in Niikawa, the use of a lens 302 fixed in a camera does not prevent the use of an attachable lens system that emulates a camera lens.

Applicant argues with respect to claim 5, that the step of displacing an eyepiece is not notoriously well known and demands that the Examiner cite specific references that would lead on to the conclusion that displacement of an eyepiece is "notoriously well-known". Therefore, the examiner cites the "National: Instructions for Stereoscopic Microscopes". Specifically, the examiner cites page 4, paragraph 2; Interpupillary Adjustment.

Applicant also argues with respect to claim 5, that the displacement of an eyepiece included in an optical instrument so as to preclude interference with an eyepiece included in a camera is patentable and not merely an intended use. First off, the use of an eyepiece in a camera is not mentioned in the claim, therefore, the examiner will interpret the argument as "to preclude the interference of an eyepiece with a camera". As interpreted by the examiner, the displacement of eyepieces in an optical instrument is notoriously well known in the art as can be seen in "National: Instructions for Stereoscopic Microscopes"; specifically, page 4, paragraph 2; Interpupillary Adjustment.

In response to applicant's argument that displacement of an eyepiece included in an optical instrument so as to preclude interference of an eyepiece with a camera, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues with respect to claim 6, that the step of displacing an eyepiece is not notoriously well known and demands that the Examiner cite specific references that would lead on to the conclusion that displacement of an eyepiece is "notoriously well-known". Therefore, the examiner cites the "National: Instructions for Stereoscopic Microscopes". Specifically, the examiner cites page 4, paragraph 2; Interpupillary Adjustment.

In response to applicant's argument that displacement of an eyepiece included in an optical instrument so as to preclude interference of an eyepiece with a camera, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument, with respect to claim 7, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that "offset-eliminating flange actively eliminates an offset introduce by other apparatus") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues with respect to claim 8, that Applicant has made no admissions within the specification which can be used to sustain a rejection under 35 USC 103(a). However, the specification page 14, lines 16-18 states that "many imaging systems that incorporate parametric image generators 45 include a camera mounting flange that includes an offset 100." As can be seen here, many imaging systems include a camera mounting flange that includes an offset, and is understood by the Examiner to mean that there are many other prior art systems that include an offset flange as claimed by the Applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 5-7, ~~and 9-16~~ ^{9-13, and 15-16} are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US Patent # 6,147,797).
2. In regard to claim 1, note Lee discloses the use of an imaging instrument comprising an optical path wherein the optical path comprises a first subject matter starting point and an original image plane ending point (figure 1: microscope 5 is considered to be the imaging instrument), attaching a quick-release receptacle to the imaging instrument (column 7, lines 17-19; and figure 6: 280 is attached to the microscope; as for the quick release feature, this can be seen in figures 11-14: as ring 340 is turned, the arms 303 are moved toward the center in order to tighten onto

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microscope feature 310), affixing a replacement camera comprising a replacement image plane and a lens mount to a camera adapter coupling (the camera captures the image on the image plane; and figure 6: the camera 210 has a lens mount 214 where the adapter 220-240 is attached to the camera) wherein the camera adapter coupling comprises a coupling end and a lens emulating flange opposing the coupling end (figure 6: the adapter has a lens emulating flange 224, this lens emulating end connects to the camera in order to emulate the camera lens; and is opposite the coupling end 284-295) and wherein the camera is affixed to the camera adapter coupling by mating the lens emulating flange with the lens mount (figure 6: lens emulating flange 224 is attached to lens mount 214), and mating the coupling end of the camera adapter coupling to the receptacle (column 7, lines 17-19).

Therefore, it can be seen that the Lee device fails to disclose the removal of an original camera attachment means from the imaging instrument. Although not explicitly stated, it would have been obvious that the removal of the original camera attachment means from the optical assemblage is necessary in order for the upgrade to be attached to the assemblage (as stated by Lee in column 1, lines 15-63 and column 2, lines 20-23; the camera adapter can be attached/detached). Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to include the removal of the original camera attachment means from the optical assemblage of an imaging instrument in order to allow the upgrade of the attachment means for a new camera.

3. In regard to claim 2, note Lee discloses that the camera is a digital camera (column 5, line 40; 210 is a digital camera).

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4. In regard to claim 3, note Lee discloses the insertion of a compensating lens into the optical path of the imaging instrument if a compensating lens is required to focus an image onto the replacement image plane or if enlargement of a subject matter image striking the replacement image plane is desired (column 4, lines 27-37; and figure 5: 80). Lee teaches that this is preferred if the camera has a lens that is not removable in order to compensate for spherical aberration and a chromatic aberration caused by the lenses of the digital camera (column 1, lines 50-55).

5. In regard to claim 5, note Lee discloses that the imaging instrument comprises an eyepiece (figure 2: 40). Therefore, it can be seen that the Lee reference fails to disclose the step of displacing the eyepiece. "National: Instructions for Stereoscopic Microscopes" discloses the use of the displacement of the eyepiece (page 4, paragraph 2: Interpupillary Adjustment). The displacement of eyepieces in optical instruments is well known in the art in order to allow the user adjust the interpupillary distance so that it may be operated by any user. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to allow the user to displace the eyepieces in order to adjust the interpupillary distance so that it may be operated by any user.

As for the limitation that the eyepiece is displaced in order to preclude physical interference of the eyepiece with the camera. This is merely an intended use and therefore holds no patentable weight. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the displacement of the eyepiece to adjust the interpupillary distance is functionally equivalent.

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6. In regard to claim 6, note Lee discloses that the imaging instrument comprises an eyepiece (figure 2: 40). Therefore, it can be seen that the Lee reference fails to disclose the step of displacing the eyepiece. "National: Instructions for Stereoscopic Microscopes" discloses the use of the displacement of the eyepiece (page 4, paragraph 2: Interpupillary Adjustment). The displacement of eyepieces in optical instruments is well known in the art in order to allow the user adjust the interpupillary distance so that it may be operated by any user. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to allow the user to displace the eyepieces in order to adjust the interpupillary distance so that it may be operated by any user.

As for the limitation that the eyepiece is displaced in order compensate for variation in the optical path resulting from displacement of the replacement image plane relative to the original image plane. This is merely an intended use and therefore holds no patentable weight. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the displacement of the eyepiece to adjust the interpupillary distance is functionally equivalent.

7. In regard to claim 7, note Lee discloses that the receptacle comprises an offset-eliminating flange (according to applicant's disclosure, the examiner considers the offset-eliminating flange to be a flange that does not introduce an offset, as can be seen in figure 6b and page 14, lines 15-21) and a capture cowling (figure 10: 204 is considered to be the offset-eliminating flange because it does not create an offset, and 280 is considered to be the capturing cowl).

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8. In regard to claims 9-13 and 15-16, these are apparatus claims, corresponding to the method of claims 1-3 and 5-6. Therefore, claims 9-13 and 15-16 have been analyzed and rejected as previously discussed with respect claims 1-3 and 5-6.

9. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US Patent # 6,147,797) in view of Feinbloom (US Patent # 4,413,278).

10. In regard to claim 4, note Lee discloses a method of upgrading an imaging system as claimed in claim 1. Therefore, it can be seen that the Lee reference fails to disclose that the length of the camera adapter coupling is adjusted to displace the replacement image plane relative to the original image plane in order to enlarge a subject matter image striking the replacement image plane relative to that same image striking the original image plane. Feinbloom discloses the use of a camera with an adapter to connect an imaging instrument (figure 1: 10, 13, and 20) as well as the adjusting of the length of the adapter (figure 5a-5c). Feinbloom teaches that by adjusting the length of the adapter it can adjust the focus so that it can be used on various devices that may have different focal lengths (column 1, lines 31-36 and column 4, lines 16-36). Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to include an adjustable adapter in order focus the device when using different imaging instruments as suggested by Feinbloom.

11. In regard to claim 14, this is an apparatus claim, corresponding to the method of claim 4. Therefore, claim 14 have been analyzed and rejected as previously discussed with respect claim 4.

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12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US Patent # 6,147,797) in view of Applicant's admitted prior art.

13. In regard to claim 8, note Lee discloses that the receptacle has a flange and a capture cowling (figure 10: 204 is considered to be the flange and 280 is considered to be the capturing cowl). Therefore, it can be seen that the Lee device lacks the use of a non-offset eliminating flange. However, based on the Applicant's admission of prior art in the specification, the use of a non-offset eliminating flange (considered an offset flange according to applicant's figure 6a) to be notoriously well known and expected in the art (page 14, lines 15-21). Therefore, it would have been obvious to one of ordinary skill in the art to modify the primary device to include the use of a non-offset eliminating flange in order to capture parametric data as suggested by Applicant.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US006704053B1: note the use of a digital camera having a lens mount structure as well as a lens fixed in the camera.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chriss S. Yoder, III whose telephone number is (571) 272-7323. The examiner can normally be reached on M-F: 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CSY
June 7, 2005


AUNG MOE
PRIMARY EXAMINER